

REMARKS

Summary of Office Action

As an initial matter, Applicants note with appreciation that the Examiner has indicated consideration of the Information Disclosure Statements filed October 24, 2006, January 30, 2007 by returning signed copies of the Forms PTO-1449 submitted therein.

Applicants further note that the present Office Action fails to acknowledge the claim for foreign priority and the receipt of a copy of the certified copy of the priority document from the International Bureau. Accordingly, the Examiner is respectfully requested to acknowledge the claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f) and the receipt of a copy of the certified copy of the priority document in the next official communication.

Claims 31 and 38 are withdrawn from consideration.

Claims 39 and 44 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 39-41 and 44 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly partially failing to comply with the enablement requirement.

Claims 14-30, 32-37 and 39-44 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stab et al., US 2006/0093633 A1 (hereafter “STAB”), in view of Max et al., US 2005/0158350 A1 (hereafter “MAX”).

Response to Office Action

Reconsideration and withdrawal of the rejection of record are respectfully requested, in view of the following remarks.

Response to Rejections under 35 U.S.C. § 112, Second Paragraph

Claims 39 and 44 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. The rejection alleges that it is unclear what “for protecting skin in cases of sensitively determined and dry skin” and “functional disorders of skin appendages” means.

Applicants respectfully traverse this rejection. Even if one were to assume, *arguendo*, that one of ordinary skill in the art does not know and cannot find out what “for protecting skin in cases of sensitively determined and dry skin” and “functional disorders of skin appendages” means, the present specification provides guidance in this regard. See, for example, page 5, line 26 to page 6, line 28, page 7, line 14 to page 8, line 9 and page 14, line 19 to page 16, line 6 of the present specification.

The Examiner’s attention further is directed to MPEP 2173.02 which states, *inter alia* (underlining in original):

The examiner’s focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable

subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Applicants submit that for at least all of the foregoing reasons, the instant rejection under 35 U.S.C. § 112, second paragraph, is unwarranted and should be withdrawn, which action is respectfully requested.

Response to Rejections under 35 U.S.C. § 112, First Paragraph

Claims 39-41 and 44 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly partially failing to comply with the enablement requirement. The rejection alleges that the specification, while being enabling for treating inflammatory skin conditions, treating symptoms of intrinsic and extrinsic skin aging, treating harmful effects of ultraviolet radiation on skin, treating pigment disorders of the skin and treating functional disorders of the skin, does not reasonably provide enablement for preventing (inflammatory?) skin conditions, preventing symptoms of intrinsic and extrinsic skin aging, preventing harmful effects of ultraviolet radiation on skin,

preventing pigment disorders of the skin or preventing functional disorders of the skin.

This rejection is respectfully traversed as well. In particular, it is submitted that one of ordinary skill in the art will recognize that in order to prevent any of the conditions set forth by the Examiner the same action is to be taken as in the case of treating these conditions, i.e., to apply the preparation of claim 20 to skin (as recited in the rejected claims).

Applicants further note that the Examiner has not provided any evidence which would support an allegation that one of ordinary skill in the art would have to carry out undue experimentation in order to be able to prevent any of the conditions set forth in the instant Office Action by applying a preparation according to present claim 20 to skin. In this regard, it is noted that even the fact that experimentation may be complex does not necessarily make it undue, if the art typically engages in such experimentation. *In re Certain Limited-Charge Cell Culture Microcarriers*, 221 USPQ 1165, 1174 (Int'l Trade Comm'n 1983), *aff'd. sub nom., Massachusetts Institute of Technology v. A.B. Fortia*, 774 F.2d 1104, 227 USPQ 428 (Fed. Cir. 1985). See also *In re Wands*, 858 F.2d at 737, 8 USPQ2d at 1404. The test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, it is undue. *In re Angstadt*, 537 F.2d 498, 504, 190 USPQ 214, 219 (CCPA 1976).

Applicants submit that for at least all of the foregoing reasons, the instant rejection under 35 U.S.C. § 112, first paragraph, is without merit, wherefore withdrawal thereof is warranted.

Response to Rejection under 35 U.S.C. § 103(a)

Claims 14-30, 32-37 and 39-44 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over STAB in view of MAX.

Applicants respectfully traverse this rejection as well. Specifically, it is pointed out that the effective U.S. filing date of the present application is November 22, 2004, i.e., the filing date of International Application PCT/EP04/13254, of which the present application is a National Stage. Accordingly, neither STAB (published July 21, 2005) nor MAX (published May 4, 2006) qualify as prior art under 35 U.S.C. § 102 (a) and (b) with respect to the instant claims.

Moreover, STAB is the National Stage of PCT/EP03/05347 which was published in German, i.e., not in English, wherefore STAB does not qualify as prior art under 35 U.S.C. § 102 (e), either. Accordingly, it is not necessary for Applicants to rely on the foreign priority papers.

It is submitted that for at least the foregoing reasons, the instant rejection under 35 U.S.C. § 103(a) is without merit as well.

CONCLUSION

In view of the foregoing, it is believed that all claims of record are in condition for allowance. Accordingly, an early issuance of the Notices of Allowance and Allowability is respectfully solicited. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned at the telephone number below.

Respectfully submitted,
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/Heribert F. Muensterer/

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